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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,959	07/16/2003	Myron K. Gordin	P05717US01	9987

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801 GRAND AVENUE
SUITE 3200
DES MOINES, IA 50309-2721

EXAMINER

KATCHEVES, BASIL S

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,959

Applicant(s)

GORDIN ET AL.

Examiner

Basil Katcheves

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. §. 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 2-8, 54 and 57-59 are objected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are combination claims which include a pole. However, they depend from claims which are subcombination claims reciting the pole cover. This is improper. Correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16, 18, 19, 21, 31-50, 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,340,790 to Gordin et al in view of U.S. Patent No. 4,543,764 to Kozikowski as in the previous office action.

Regarding claims 1, 42, Gordin discloses a sleeve positionable around a part of an existing pole (fig. 11) with a diameter of at least several inches. However, Gordin does not disclose the sleeve as being made of a non-corrosive material. Kozikowski

discloses the use of a vinyl sleeve for poles (column 4, lines 67-68). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gordin by adding a vinyl sleeve, as disclosed by Kozikowski in order to prevent rust from destroying the pole. Also, the prior art discloses the basic claim structure of the instant application but does not disclose specific sleeve dimensions as in the application. Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims for use with heavy or light loads.

Regarding claims 2, 46, Gordin discloses the basic claim structure of the instant application but does not disclose specific dimensions of the pole. Applicant fails to show criticality for specifically claimed dimensions of the pole, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 3, Gordin discloses the pole as tubular.

Regarding claim 4, Gordin discloses the use of steel for building poles (column 2, lines 28-29).

Regarding claim 5, Gordin discloses the pole as tapered (fig. 11).

Regarding claim 6, Gordin discloses the pole as slip fitted to a base in the ground (fig. 12).

Regarding claim 7, Gordin discloses the pole as being elongated (fig. 7).

Regarding claim 8, Gordin discloses the pole as being made of a plurality of sections (fig. 7: 72 & 76).

Regarding claim 9, Gordin does not specifically disclose the sections as slip fitted together, however the sections are inherently capable of being slip fitted together, as they have a truncated conical shape enabling them to do so.

Regarding claim 10, Gordin in view of Kozikowski discloses a covering layer for pole sections.

Regarding claims 11, 12, 48, 49, Gordin discloses the layers as overlapping (fig. 7).

Regarding claim 13, Gordin discloses the sleeve as a covering sheet material.

Regarding claim 14, Gordin discloses the use of steel which is flexible.

Regarding claims 15, 16, 50, Gordin in view of Kozikowski discloses the use of vinyls and other similar components (column 4, line 67 – column 5, line 20).

Regarding claim 18, Gordin discloses the basic claim structure of the instant application but does not disclose specific dimensions. Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 19, Gordin in view of Kozikowski discloses the sleeves as having a top, bottom, and sides if placed in an unrolled position.

Regarding claim 21, Gordin discloses the sleeve as being in a trapezoidal shape when in a flat configuration, since Gordin disclose the sleeve as a truncated cone shape.

Regarding claims 31, 32, Gordin discloses an opening in the covering layer (fig. 11: see bottom of 92) for fitting over the conical structure at the top of the pole.

Regarding claims 33, 34, Gordin discloses a sealant (fig. 11: 108) between the sleeve and top of pole.

Regarding claim 35, Gordin discloses the sealant as inherently capable of being similar to a caulk type material (fig. 11: see spread on 108).

Regarding claim 36, Gordin discloses the sleeves as substantially covering the pole (fig. 7).

Regarding claim 37, Gordin discloses the sleeves as having an inherent color.

Regarding claim 38, 39, Gordin does not specifically disclose the pole as being colored to match an environmental feature or specific team colors. It would have been obvious to one having ordinary skill in the art at the time the invention was made to paint the sleeves with an appropriate team color or turf color, as stadiums throughout the world are regularly painted to match a theme or their home team colors.

Regarding claims 40, 41, 53, Gordin discloses the sleeves as having the texture and pattern of a pole.

Regarding claim 43, Gordin does not disclose the sleeves as wrapped around the pole. Kozikowski discloses the sleeve as wrapped around the pole (column 2, lines 59-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gordin by wrapping the sleeves, as disclosed by Kozikowski in order to speed repair and construction.

Regarding claim 44, Gordin in view of Kozikowski discloses securing the sleeves relative to one another (Kozikowski fig. 2: see edges between numerals 26 & 28).

Regarding claim 45, Gordin discloses the sleeves as secured from longitudinal movement (fig. 7).

Regarding claim 47, Gordin discloses the sleeves as tapered (fig. 11) and if placed in a flat position, would inherently be trapezoidal.

Regarding claim 52, Gordin discloses the top of the sleeves as sealed to the top of the pole (108).

Regarding claim 54, claim 54 is rejected for reasons cited in the rejections of claims 1, 2 and 36.

Claims 20, 22-27, 51, 55-64, 67-81, and 84-89, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,340,790 to Gordin et al in view of U.S. Patent No. 4,543,764 to Kozikowski further in view of U.S. Patent No. 3,968,561 to Oakes et al. as in the previous office action.

Regarding claim 20, 51, Gordin in view of Kozikowski does not disclose the sleeves, when laying flat, as having the opposite side edges rolled into a U shape. Oakes discloses a pole sleeve having opposite edges rolled into a U shape (fig. 2: 21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gordin in view of Kozikowski by using the U shaped ends of Oakes in order to secure the sleeve around the pole in a tighter manner.

Regarding claim 22, Gordin discloses the sleeve as being in a trapezoidal shape when in a flat configuration, since Gordin disclose the sleeve as a truncated cone shape.

Regarding claim 23, 60, 77, Gordin discloses the side edges as not overlapping (fig. 7).

Regarding claim 24, 61, 78, Oakes discloses a C shaped fastener to secure the sleeve (fig. 2: 19).

Regarding claim 25, 62, 79, Oakes discloses the fastener as having a base and inwardly angled walls at opposite sides defining an opening (fig. 2: 19).

Regarding claims 26, 27, 63, 64, 80, 81, Oakes discloses the walls as inherently deformable.

Regarding claim 55, claim 55 is rejected for reasons cited in the rejections of claims 20, 22, and 24.

Regarding claim 56, Gordin discloses a sleeve positionable around a part of an existing pole (fig. 11). However, Gordin does not disclose the sleeve as being made of a non-corrosive material. Kozikowski discloses the use of a vinyl sleeve for poles (column 4, lines 67-68). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gordin by adding a vinyl sleeve, as disclosed by Kozikowski in order to prevent rust from destroying the pole. The prior art combination discloses the basic claim structure of the instant application but does not disclose the specific dimensions of the application. Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

In addition, claim 56 is also rejected for reasons cited in the rejection of claim.20.

Regarding claim 57, Gordin in view of Kozikowski further in view of Oakes discloses the basic claim structure of the instant application but does not disclose specific dimensions. Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 58, Gordin discloses the sleeve as tapered (fig. 11).

Regarding claim 59, Gordin discloses the pole as being elongated (fig. 7).

Regarding claim 67 Gordin discloses the sleeves as substantially covering the pole (fig. 7).

Regarding claim 68, Gordin discloses the sleeves as having an inherent color.

Regarding claim 69, 70, Gordin does not specifically disclose the pole as being colored to match an environmental feature or specific team colors. It would have been obvious to one having ordinary skill in the art at the time the invention was made to paint the sleeves with an appropriate team color or turf color, as stadiums throughout the world are regularly painted to match a theme or their home team colors.

Regarding claims 71 and 72, Gordin discloses the sleeves as having the texture and pattern of a steel pole.

Regarding claim 73, claim 73 is rejected for reasons cited in the rejection of claims 20 and 22.

Regarding claim 74, Gordin discloses the basic claim structure of the instant application but does not disclose specific dimensions of the pole. Applicant fails to

show criticality for specifically claimed dimensions of the pole, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 75, Gordin discloses the pole as tapered (fig. 11).

Regarding claim 76, Gordin discloses the pole as being elongated (fig. 7).

Regarding claim 84, Gordin discloses the sleeves as substantially covering the pole (fig. 7).

Regarding claim 85, Gordin discloses the sleeves as having an inherent color.

Regarding claim 86, 87, Gordin does not specifically disclose the pole as being colored to match an environmental feature or specific team colors. It would have been obvious to one having ordinary skill in the art at the time the invention was made to paint the sleeves with an appropriate team color or turf color, as stadiums throughout the world are regularly painted to match a theme or their home team colors.

Regarding claims 88, 89, Gordin discloses the sleeves as having the texture and pattern of a steel pole.

Claims 28-30, 82 and 83, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,340,790 to Gordin et al in view of U.S. Patent No. 4,543,764 to Kozikowski further in view of U.S. Patent No. 4,092,079 to Swanson as in the previous office action.

Regarding claims 28 and 82, Gordin in view of Kozikowski does not disclose the use of fasteners. Swanson discloses a sleeve for a pole using fasteners to secure the

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sleeve (fig. 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gordin in view of Kozikowski by using fasteners, as disclosed by Swanson, in order to better secure the sleeves.

Regarding claim 29, 83, Swanson discloses the use of screws (49).

Regarding claim 30, Swanson discloses bolts (49) and nuts (51).

Claims 65 and 66, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,340,790 to Gordin et al in view of U.S. Patent No. 4,543,764 to Kozikowski further in view of U.S. Patent No. 3,968,561 to Oakes et al. further in view of U.S. Patent No. 4,092,079 to Swanson as in the previous office action.

Regarding claim 65, Gordin in view of Kozikowski further in view of Oakes does not disclose the use of fasteners. Swanson discloses a sleeve for a pole using fasteners to secure the sleeve (fig. 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gordin in view of Kozikowski further in view of Oakes by using fasteners, as disclosed by Swanson, in order to better secure the sleeves.

Regarding claim 66, Swanson discloses screws (49).

Response to Arguments

Applicant's arguments filed 2/9/06 have been fully considered but they are not persuasive. Applicant argues that Gordin does not disclose a sleeve positionable around a pole. However, the applicant should note that Gordin discloses a member fitting around the existing pole as noted in the rejection above. This sleeve of Gordin meets the structural claimed limitations of the applicant, and therefore may be construed as such. Applicant argues that Kozikowski does not teach a conical sleeve being a fraction of an inch thick. The applicant should note that Gordin teaches a conical cover and that Kozikowski teaches a support sleeve made of plastic combined with the sleeve of Gordin. The applicant also argues that Kozikowski is not a layer that provides no structural support. The applicant should note that this is a negative function. Because the prior art functions in a manner capable of supporting a load, it also teaches that it may function in a manner without a load. Applicant argues the filler material of Kozikowski teaches away from combining with Gordin. However, both inventions are related to placement around existing poles and both act in the same manner. The applicant argues that Oaks is non analogous art. However, Oaks is concerned with tubular structural members and how further reinforce them. Applicant argues that the Swanson reference teaches away from the instant application. The applicant should note that the Swanson reference is used to combine with the prior art cited and not with the instant application. Because the applicant claims a negative limitation, of not being capable of supporting a load, the prior art still meets this

limitations as the limitation is a functional limitation and the prior art used may perform in a manner where no load is applied.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited patents listed on the included form PTO-892 further show the state of the art with respect to poles in general.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is (571) 272-6846. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman, can be reached at (571) 272-6842.

BK


Basil Katcheves

5/4/06

Examiner AU 3635